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EXAMINER

CIRIC, LJILJANA V

ART UNIT	PAPER NUMBER
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3743

DATE MAILED: 04/14/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No. <b>09/865,182</b>	Applicant(s) <b>Sato et al.</b>
Examiner <b>Ljiljana V. Ciric</b> <i>LVC</i>	Art Unit <b>3743</b>



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on Oct 10, 2002 and on Jan 15, 2003
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-15 is/are pending in the application.
- 4a) Of the above, claim(s) 5, 9, and 11-14 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-4, 6-8, 10, and 15 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claims \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on May 24, 2001 is/are a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☒ All b) ☐ Some\* c) ☐ None of:
- ☒ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s). 7 6) ☐ Other: \_\_\_\_\_

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## **DETAILED ACTION**

### ***Election/Restriction***

1. Applicant's election without traverse of the invention corresponding to Group I and the third species corresponding to the embodiment of Figure 5 in Papers No. 4 and 6 is acknowledged.

2. Claims 1 through 15 remain in the application, of which claims 1 through 4, 6 through 8, 10, and 15 are readable on the elected invention as indicated by the applicant in Paper No. 6. All of claims 1 through 4, 6 through 8, 10, and 15 have been amended via Paper No. 4.

3. Claims 5, 9, and 11 through 14 are hereby withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to non-elected inventions, there being no allowable generic or linking claim. Election was made without traverse in Papers No. 4 and 6.

### ***Response to Amendment***

4. The amendment filed on October 10, 2002 (i.e., Paper No. 4) is objected to under 35 U.S.C. 132 because it introduces new matter into the disclosure. 35 U.S.C. 132 states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows: the air conditioner comprising two (a first and a second) distinct air conditioning unit, with each being used for performing air conditioning of the compartment, as opposed to the air conditioner comprising a single two-piece (or two-part) air conditioning unit as originally disclosed and claimed.

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Applicant is required to cancel the new matter in the reply to this Office Action.

***Priority***

5. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

***Drawings***

6. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the following features must be shown or the feature(s) canceled from the claim(s): a *plurality* of pins provided on at least one of the first and second air conditioning units and a *plurality* of corresponding attachment portions with holes as recited in base claim 1; No new matter should be entered.

A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

***Specification***

7. The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required: there appears to be no clear antecedent basis in the specification for a plurality of attachment portions as recited in the claims; there appears to be no antecedent basis in the specification for an engagement portion as recited in the claims; and, there also appears to be no antecedent basis in the specification for a fastening member as recited in the claims.

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***Claim Objections***

8. Claims 1 through 4, 6 through 8, 10, and 15 are objected to because of the following informalities, for example: a comma (,) should be inserted immediately following “attachment portions” [claim 1, line 8] for improved readability and grammatical correctness; and, “is an elongated hole” [claim 10, line 2] should be replaced with “is elongated” for improved conciseness and readability. Appropriate correction is required.

***Claim Rejections - 35 U.S.C. § 112***

9. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

10. Claims 1 through 4, 6 through 8, 10, and 15 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The amended claims recite the inventive connection structure as being disposed between two (a first and a second) distinct air conditioning units, with each unit being used for performing air conditioning of the compartment, the implication being that each of these first and second air conditioning units is a distinct, working air conditioner in its own right. There is no support for this newly added material in the originally filed disclosure, which provides clear support only for the inventive connection structure being disposed between the two operating units of a single air conditioner as originally claimed, the two operating units being

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complementary units and not distinct units for providing air conditioning within the compartment.

The limitations relating to the distinct first and second air conditioning units thus represent new matter not described in the originally filed disclosure.

11. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

12. Claims 1 through 4, 6 through 8, 10, and 15 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The claims appear to be a literal translation into English from a foreign document and contain grammatical and idiomatic errors. For example, the limitation “in *a* direction *crossing* with” [claim 1, line; claim 2, line 2] is idiomatically improper and is not clearly understood as written, thus rendering the metes and bounds of protection sought indefinite.

Additionally, the terminology appearing in the claims does not directly nor clearly correlate to corresponding terminology in the specification as originally filed, thus leading to confusion as to which elements recited in the claims correspond to which elements as mentioned and described in the specification. For example, the claims recite “attachment portions” for which there is no clear antecedent basis in the specification; yet, to confuse matters further, the specification refers to attachment stays 211, 212, 213, and 280 (all of which have corresponding through holes”, as well to an attachment portion 360 [see page 9, line 9] *and* to an attachment pin 360 [see page 9, line 6]. The specification also describes the air conditioner as being “mechanically fastened by bolts and the

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like using attachment stays 211, 311, 312" [see page 8, lines 10-12], but, there being no clear antecedent basis in the specification for the term "fastening member" [claim 1, line 11], it is not clear whether the term "fastening member" refers to bolts, to the attachment stays 211, 311, and 312, or to some other element(s). Hence, in particular due to this latter situation, the claims cannot be interpreted with certainty and are thus further indefinite with regard to the scope of protection sought.

Also with regard to claim 1 as written, the limitations following "a fastening member" as recited in lines 11 through 13 of the claim, i.e., "which fastens both the first and second air conditioning units after the pins are fitted into the holes of the attachment portions, respectively", appear to recite method steps in an apparatus claim, thus further rendering the metes and bounds of protection sought indefinite.

With regard to claim 2 as written, there appears to be text missing immediately following "protruding to" in line 2 of the claim. This missing text renders the metes and bounds of protection sought by claim 2 and claims 3, 4, 6 through 8, and 10 depending therefrom indeterminate.

The term "approximately" in claim 8 is a relative term which renders the claim indefinite. The term "approximately" is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention. Thus, as used to describe the relative corresponding dimensions of the plate portion and the recess, this term renders the same indeterminate and the claims indefinite.

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Also with regard to claim 8 as written, it is not clear what is encompassed by the recitation of “*a dimension* of the recess in the insertion direction”, further rendering claim 8 indefinite. For example, does the recitation of “a dimension” refer to a particular dimension of the recess, such as a depth or a length or a width or a thickness of recess? If so, this particular dimension should be directly recited in the claim. If not, then the claim is of indefinite scope since the recess has an unlimited number of potential corresponding dimensions.

With regard to claim 15 as written, it is not clear whether or not any particular structure is associated with the recitation of “an inside/outside air unit” and of “an air temperature adjusting unit”, each for accomplishing a particular purpose. It is also not clear whether applicant intends these limitations to be interpreted as “means plus function” limitations. Absent a statement by applicant to that effect and absent the explicit use of the phrase “means for”, these limitations are, however, interpreted broadly and not as invoking 35 U.S.C. 112, sixth paragraph. *Cf. Seal-Flex, Inc. v. Athletic Track and Court Construction*, 172 F.3d 836, 849-50, 50 USPQ2d 1225, 1233-34 (Fed. Cir. 1999). Also *Cf. Morris*, 127 F.3d at 1055, 44 USPQ2d at 1028. Also *Cf. Rodime PLC v. Seagate Technology, Inc.*, 174 F.3d at 524, 531, 41 USPQ2d 1429, 1435-36 (Fed. Cir. 1999).

The above is an indicative, but not necessarily an exhaustive, list of 35 U.S.C. 112, second paragraph, problems. Applicant is therefore advised to carefully review all of the claims for additional problems. Correction is required of all of the 35 U.S.C. 112, second paragraph problems, whether or not these were particularly pointed out above.



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***Claim Rejections - 35 U.S.C. § 102***

13. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

14. As best can be understood in view of the indefiniteness of the claims, claims 1 and 15 are rejected under 35 U.S.C. 102(b) as being anticipated by *Mitsubishi Heavy Industry Ltd. (JP2000-16057 A)*.

*Mitsubishi Heavy Industry Ltd. (JP2000-16057 A)* discloses an air conditioner with a connection structure essentially as claimed, including: an air conditioner comprising a casing 12 divided into two members, each casing member and corresponding working elements therein being readable on one of the first and second air conditioning units as claimed in the instant application; a plurality of positioning pins 23 provided on at least one of these air conditioning units [see Figures 3 and 5]; a corresponding plurality of attachment portions including corresponding positioning holes 18 [also see Figures 3 and 5]; and, a plurality of fastening members or screws 19 insertable into screw holes 17 [also see Figures 3 and 5].

The reference thus reads on the claims.

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NOTE: Applicant cannot rely upon the foreign priority papers to overcome this rejection because a translation of said papers has not been made of record in accordance with 37 CFR 1.55. See MPEP § 201.15.

15. Alternately and as best can be understood in view of the indefiniteness of the claims, claims 1 and 15 are rejected under 35 U.S.C. 102(a) as being anticipated by *Mitsubishi Heavy Industry Ltd. (JP2000-16057 A)*.

*Mitsubishi Heavy Industry Ltd. (JP2000-16057 A)* discloses an air conditioner with a connection structure essentially as claimed, including: an air conditioner comprising a casing 12 divided into two members, each casing member and corresponding working elements therein being readable on one of the first and second air conditioning units as claimed in the instant application; a plurality of positioning pins 23 provided on at least one of these air conditioning units [see Figures 3 and 5]; a corresponding plurality of attachment portions including corresponding positioning holes 18 [also see Figures 3 and 5]; and, a plurality of fastening members or screws 19 insertable into screw holes 17 [also see Figures 3 and 5].

The reference thus reads on the claims.

16. The non-application of art against claims 2 through 4, 6 through 8, and 10 should not be construed as an indication that the claims contain allowable subject matter but rather that the claims could not be examined on the merits due to indefiniteness.

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***Conclusion***

17. The following prior or other relevant art made of record and not relied upon is considered pertinent to applicant's disclosure. *Anderson, Duell et al., Blackburn et al., Jacquet et al., Haas, Jacquet, Mino et al., Granström et al., Ashida et al., Steege et al., Takasaki, Jocham et al., Scoccia et al., Hitachi Seisakusho K.K., Mitsubishi Electric Corp. (all), Borletti Climatizzazione S.r.l., Sanyo Electric Co. Ltd. (all), Daikin Ind. Ltd. (all), Denso Corporation (all), Fujitsu General Ltd., Zexel Corp., Calsonic Kansei Corp., and Japan Climate Systems Corp.* each discloses an air conditioner or heat exchanger including connection structure of interest.

18. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ljiljana (Lil) V. Ciric, whose telephone number is (703) 308-3925. While she works a flexible schedule that varies from day to day and from week to week, Examiner Ciric may generally be reached at the Office during the work week between the hours of 10 a.m. and 6 p.m. ET.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Henry Bennett, can be reached on (703) 308-0101. The fax number is (703) 305-3463. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0861.

lvc

April 5, 2003



LJILJANA V. CIRIC  
PRIMARY EXAMINER  
ART UNIT 3743